

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Motoo SUMIDA et al.)	Confirmation No: 5291
)	
U.S. Application No.: 10/527,703)	Group Art Unit: 1657
)	
Filing Date: October 13, 2005)	Examiner: Herbert J. Lilling
)	
For: PROCESS FOR PRODUCTION OF)	
TRANSESTERIFIED OILS/FATS OR)	
TRIGLYCERIDES)	

RESPONSE TO NOTICE OF NON-COMPLIANT AMENDEMENT
AND
APPLICANTS' SUMMARY OF AN INTERVIEW

Mail Stop: AMENDMENT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants submit the following response to the Notice mailed July 3, 2008. This response is timely filed on or before August 4, 2008, by virtue of August 3rd falling on a Sunday.

Remarks begin on page 2.

REMARKS

Applicants express gratitude for the courtesies extended in a telephonic interview between the Examiner and Applicants' counsel on July 16, 2008. The following remarks reflect Applicants' understanding of the content of the interview.

Background

In an Office Action mailed November 8, 2007, the Examiner among other things required Applicants to elect a species within **Group II**, claims 10-16 and 22, directed to a transesterified oil/fat or triglyceride product, in part along the following lines:

"A. Whereby the product produced is:

(a) 20% of polyunsaturated fatty acids (PUFA) containing 20 or more carbons and two or more double bonds with a specific generic structure.

Ai arachidonic acid;

Aii dihomogamma-linolenic acid

Aiii [*sic*: Mead] acid

(b) omega 6 series PUFA:

bi specify a structure.

(c) omega 9 series PUFA;

ci specify a structure."

In response to a request by Applicants' counsel, the Examiner issued a revised restriction requirement on November 29, 2007. The revised restriction requirement did not change the species election above.

In a response filed May 2, 2008, Applicants' responded to the revised restriction requirement in part by electing the species A(a) arachidonic acid, A(b) ω6 series PUFA, and A(c) ω9 series PUFA.

In a Notice of Non-Responsive Amendment mailed July 3, 2008, the Examiner purports that species election under part (A) meant to state:

A. Whereby the product produced is:

(a) *either an oil/fat or a triglyceride containing 20% of PUFA containing 20 or more carbons and two or more double bonds, wherein the PUFA is:*

- (i) arachidonic acid;
- (ii) dihomo-gamma-linolenic acid; *or*
- (iii) Mead acid; **OR**

(b) *either an oil/fat or a triglyceride containing an omega 6 series PUFA;*

OR

(c) *either an oil/fat or a triglyceride containing an omega 9 series PUFA.*

The Examiner revises Part (A) of the restriction requirement to the extent that it constitutes a *revised requirement for election of a species*. Applicants accordingly consider the response filed May 2, 2008, as a full and complete response to the first restriction requirement.

Species Election

In response to the revised restriction requirement above, Applicants elect *with traverse* the species responsive to Part (A) to be:

A transesterified triglyceride containing at least 20% arachidonic acid, obtained by the process according to claim 1, which contains at least 40% of triglycerides with one residue of arachidonic acid in the molecule and/or no more than 4.0% of a triglyceride with 3 residues of arachidonic acid in the molecule.

Claims 10 and 14 read on the elected species.

Traverse of the Species Election

Applicants traverse the revised restriction requirement to elect a species for the following reasons, in addition to those reasons provided in the response filed May 2, 2008:

(1) The requirement to elect a species is contrary to the holding of *In re Weber*.

Restriction requirements are a procedural tool designed to reduce the Office's administrative burdens. The Office does not reduce its own administrative burden properly by shifting onto Applicants the costs of prosecuting a potential myriad of applications directed to overlapping subject matter. The Court of Customs and Patent Appeals held thirty years ago that such a policy contravenes Applicants' statutory right under 35 U.S.C. § 112, second paragraph, to present "one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." See *In re Weber*, 580 F.2d 455, 458 (C.C.P.A. 1978). In this regard, the restriction requirement requires an election of elements not even claimed, clearly contrary to the Court's holding in *Weber*.

(2) The requirement to elect a species does not give the required deference to the International Searching Authority.

The Office does not possess unfettered authority to restrict the claims at its own discretion in a National Stage application, even when a reference allegedly teaches a technical feature that otherwise would provide unity of invention. See MPEP § 1850. The Examiner alleges that references D1, D2, D4, and D5 in the International Search Report teach the special technical feature recited in the independent claims. Office Action mailed November 8, 2007, page 2. If an independent claim allegedly does not avoid the prior art, the examiner still must consider whether the dependent claims and species recited therein retain "an inventive link":

If, however, an independent claim does not avoid the prior art, then the question whether there is still an inventive link between all the claims dependent on that claim needs to be carefully considered. If there is no link remaining, an objection of lack of unity *a posteriori* (that is, arising only after assessment of the prior art) may be raised. Similar considerations apply in the case of a genus/species or combination/subcombination situation. MPEP § 1850(II), ¶ 8.

Further restriction is justified in this situation only if the "remaining subject matter of each claim differs from that of the others." MPEP § 1850(II), ¶ 4. "[T]he benefit of any doubt is given to the applicant." *Id.* Notably, in this context, the MPEP states that the "decision with respect to unity of invention rests with the International Search Authority [ISA] or the

International Preliminary Examining Authority," i.e., *not* the examiner of the corresponding National Stage application. *See* MPEP § 1850(II), ¶ 5.

Although citing "X" references against the independent claims, the ISA nevertheless searched *all* the species (and all the claims, for that matter) that the present Examiner would subject to restriction. *See* International Search Report mailed March 18, 2004. Clearly, the ISA did not consider the subject matter of the dependent claims to differ sufficiently from that of the others to warrant a restriction requirement. The determination of unity of invention rests with the ISA, who in this case searched all the claims. *See* MPEP § 1850(II), ¶ 5. Properly giving Applicants the benefit of the doubt, the Examiner should rejoin and examine *at least* all the recited species in Group II. *See* MPEP § 1850(II), ¶ 4.

(3) There is no serious burden on the Office to search all the "species" within Group II.

Further, restriction is proper only if the inventions are independent or distinct as claimed *and* there would be a serious burden on the examiner if restriction were not required. *See* MPEP §§ 803, 808; *see also* MPEP § 808.02 (establishing burden). Applicants' previous arguments with respect to the burden of search is incorporated here by reference. How can the Office allege that the burden of search is *serious* when the ISA *already has searched* all the claimed subject matter?

Applicants note further that the species are recited in dependent claims. MPEP § 806.04(f) states "to require restriction between claims limited to species, the claims must not overlap in scope." At the very least, MPEP § 806.04(f) requires the Examiner to justify why claims issuing on the allegedly separate and distinct species would not overlap in scope. *See also* MPEP § 806.05 ("Related inventions in the same statutory class are . . . not overlapping in scope, if a first invention would not infringe a second invention, and the second invention would not infringe the first invention."). The Examiner is totally silent in this regard.

Requested Revision to the Requirement to Elect a Species

Applicants respectfully request the Office to revise the restriction requirement so that dependent claims 11-16 each are directed to a *single species*, leaving only six species in the claims. Applicants particularly note that the present, revised requirement to elect a species requires an election of elements that are not even claimed, e.g., the microorganism used to produce the claimed fat/oil or triglyceride. While the present, revised restriction requirement is unduly burdensome to Applicants and improper for the reasons cited above, a revision of the restriction requirement to six species altogether reflects what Applicants believe to be a reasonable compromise between the Office's burden of search and Applicants burden of prosecuting the subject matter of the application.

For all the reasons above, the requirement to elect a species is improper and should be withdrawn in its entirety. At the very least, Applicants request that the Office revise the requirement as set forth above.

Attorney Docket: 47237-0528-00-US
U.S. Patent Application No.: 10/527,703
Response to Notice Mailed: July 3, 2008
Response Dated: August 4, 2008

CONCLUSION

Should additional fees be necessary in connection with the filing of this paper, or if a petition for extension of time is required for timely acceptance of same, the Commissioner is hereby authorized to charge Deposit Account No. 50-0573 for any such fees; and Applicants hereby petition for any needed extension of time.

Respectfully submitted,
DRINKER BIDDLE & REATH, LLP

Date: August 4, 2008

By: 

Brian K. Lathrop, Ph.D., Esq.
Registration No. 43, 740

DRINKER BIDDLE & REATH LLP
1500 K Street, NW Suite 1100
Washington, D.C. 20005
T: (202) 842-8821
F: (202) 842-8465